

## **II. Remarks**

Consideration and allowance of the subject application are respectfully requested.

Claims 27-105 are pending in the application. Claims 27, 49, 52, 69, and 86 are independent.

Claims 27-48 and 52-105 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 98/07282 to Owen et al. ("Owen") in view of International Publication No. WO 97/29443 to O'Brien et al. ("O'Brien"). Claims 49, 50, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,577,858 to Gell ("Gell") in view of Owen. These rejections are respectfully traversed.

Independent Claim 27 recites a telecommunication system. The system comprises a first user interface and a second user interface interconnected by a telecommunications network. The first user interface is connected to at least one computer processor and electronic memory means for executing a first set of programming code that determines said first user interface's requirements for communicating with the second user interface. The telecommunication network is connected to said at least one computer processor and electronic memory means for executing a second set of programming code that determines available network resources of said network. The at least one computer processor and electronic memory means are operable to execute a third set of programming code that manages negotiations between said first set of programming code and said second set of programming code. The negotiations

are for determining terms of communication between said first user interface and said second user interface through said network. The negotiations are based on a trusted negotiating discipline.

With respect to Claims 27-30, 33, 36-38, 41, 42, 51-55, 58, 61-63, 69-72, 75, 78-80, 86-90, 93, and 96-98, after citing several recited claim elements that are allegedly disclosed in Owen, it is indicated at page 3 of the Office Action that:

Owen fails to disclose said telecommunication network connected to said at least one computer processor and electronic memory means for executing a second set of programming code that determines available network resources of said network.

Then, referring to O'Brien as being "in the same field of endeavor", the Office Action indicates that these elements are allegedly disclosed in O'Brien.

However, Applicants submit that Owen and O'Brien are not actually in the same field of endeavor as the present invention, or as each other. Owen relates to a connection management system for setting up connections in a telecommunication network, similarly as does the present invention. In contrast, O'Brien is related to an agent for use in a distributed computing environment, and is intended to be used for managing information in a large organization.

Accordingly, O'Brien does not relate to the operation of a telecommunication system. Furthermore, in contradiction to the statement at page 3 of the Office Action that "O'Brien discloses a system for telecommunications network . . .", in fact, O'Brien fails to refer to a "telecommunications" system or network at all.

Applicants submit that a "communication network" that links computing nodes for running a distributed processing environment differs strikingly from a "telecommunications network" used by unrelated users of users of user

interfaces. Therefore, Owen and O'Brien relate to two separate and distinct fields of endeavor.

Furthermore, the Office Action fails to provide an objective motivation for combining the Owen reference with the O'Brien reference. For the claims referred to above, the Office Action indicates at page 4 that "[t]he motivation would have been to increase the services for network and improve the quality of signal." For other claim groups, the Office Action indicates that "the motivation would have been to provide a lowest cost communication", "... to provide a customer with a billing on the fly", "... to prevent a congestion such as an overbook", "... to reduce cost for user", and "... to support multimedia network between the users".

These "motivations" set forth in the Office Action are nothing more than subjective suppositions ("to increase the services for network and improve the quality of signal") unsupported by any **objective** teaching in the art. The Office Action fails to set forth a *prima facie* case of obviousness by failing to point out **where** the art teaches the alleged motivation set forth. The law is clear that, in order to prevent hindsight reconstruction, such a *prima facie* case can be established **only** by showing some **objective** teaching in the cited art which would lead an individual of ordinary skill in this art to combine the relevant references. See Ex parte Levengood, 28 USPQ2d 1300, 1302 (Patent Office Board of Appeals 1993). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of

references can be combined **only** if there is some suggestion or incentive to do so. The mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1578, 221 USPQ 929, 933 (Fed. Cir. 1984). It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. See In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Section 2143.01 of the Manual of Patent Examining Procedure stresses the essential point:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . . See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ 2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references).

In the Office Action, it is clear that the different claim elements were found by picking and choosing among the available art, and then hindsight reconstruction was used to combine them. If the enunciated suggestion is legally sufficient to combine these references, then no claim would ever issue because every claim is a combination of known elements which exist in the prior art. The law requires something more than a general allegation of “optimal performance.” The law requires an **objective** “suggestion” or “motivation” which would have

caused a person of ordinary skill in the art *at the time* to combine the references in the manner proposed. Here, such an **objective** “motivation” is clearly lacking.

With respect to the “telecommunication network connected to at least one computer processor” and “electronic memory means for executing a second set of programming code that determines available network resources of said network” elements of independent Claims 27, 52, 69, and 86, the Office Action candidly concedes that Owen fails to disclose such a system, but reasons that it would have been obvious to combine Owen with O’Brien “to increase the services for network and improve the quality of signal”. First, an explanation is required as to how O’Brien can be combined with something Owen admittedly does not disclose to render obvious something that is claimed. Second, the purported “motivation”, again, is no more than subjective hindsight reconstruction, for the reasons set forth above.

Accordingly, this rejection should be withdrawn, because the Office Action fails to make out a *prima facie* case of obviousness, since it does not set forth any **objective** evidence (other than an unsupported opinion) as to the motivation which would lead the person of ordinary skill in the art at the time to combine the cited references in the manner proposed.

Furthermore, even if sufficient motivation to combine Owen and O’Brien is assumed to be present, Applicants submit that the combination of Owen and O’Brien fails to disclose each and every element of independent Claim 27. Independent Claim 27 recites “electronic memory means for executing a second set of programming code that determines available network resources of said

network" (emphasis added). Each of independent Claims 52, 69, and 86 also recite an element that is virtually identical or equivalent to this recitation. While it is conceded that Owen fails to disclose this recited claim element, the Office Action indicates that the element is disclosed by O'Brien. However, although O'Brien discloses an agent that holds data relating to network resources controlled by or available to that agent, O'Brien fails to disclose a means for determining available network resources of the entire network (i.e., the entire distributed computing environment disclosed by O'Brien, which would be the closest analogy to the telecommunication network of the present invention).

In addition, independent Claim 27 recites "a third set of programming code that manages negotiations between said first set of programming code and set second set of programming code, said negotiations for determining terms of communication between said first user interface and said second user interface through said network". At page 3 of the Office Action, it is alleged that Owen discloses this recited claim element. However, on that same page, it is admitted that Owen fails to disclose the second set programming code itself. In fact, at page 19 of Owen, it is stated that "the negotiation process only occurs between the user agents. Thus, while Terminal Agents and Network Agents exist, there is no intelligence in these agents for the purpose of the present description." Therefore, Applicants submit that, because Owen fails to disclose a network agent that has intelligence, and because it is admitted in the Office Action that Owen fails to disclose an agent that determines available network resources, it is not possible for Owen to disclose a negotiation agent that manages negotiations

between the interface communication requirements (corresponding to the first set of programming code) and the available network resources (corresponding to the second set of programming code).

Still further, at page 3 of the Office Action, it is asserted that Figure 9 of Owen discloses a "negotiating discipline". However, a careful inspection of Figure 9 of Owen reveals that Figure 9 discloses the strategy used by a user agent in negotiating. In contrast, the term "negotiating discipline", as recited in each of independent Claims 27, 52, 69, and 86, refers to the manner in which the negotiations proceed, as opposed to the negotiating strategy used by the parties. For example, as recited in Claim 47, the negotiating discipline of the present invention may include at least one of a round robin, a bid-and-ask, bluffing, poker, and a reverse auction. Accordingly, Applicants submit that Owen also fails to disclose a negotiating discipline, as recited in independent Claims 27, 52, 69, and 86.

Therefore, independent Claims 27, 52, 69, and 86 should be allowed for each of the reasons set forth above. In addition, each of Claims 28-48, 53-68, 70-85, and 87-105 depends from one of independent Claims 27, 52, 69, and 86. Therefore, each of these dependent claims should be allowed for the same reasons as those set forth above with respect to independent Claims 27, 52, 69, and 86.

Independent Claim 49 recites a computer-implemented method for negotiating terms of communication between a first user interface and a second user interface connected by a telecommunications network. The method

comprises the steps of receiving, from a first set of programming code associated with said first user interface, an offer for said terms of communication, said first user interface's offer including said first user interface's requirements for communicating with said second user interface through said network; verifying said first user interface's offer conforms with a trusted negotiation discipline; presenting said first user interface's offer to a second set of programming code associated with said network if said first user interface's offer conforms with said discipline; receiving, from said second set of programming code, another offer for said terms of communication, said another offer including at least said network's available resources for said communication, and including a modification of said first user interface's offer; returning said another offer to said first set of programming code if said another offer conforms with said discipline; repeating the foregoing steps if said offers conform with said discipline; terminating said negotiating if any one of said offers and counteroffers fail to converge according to said negotiation discipline; and notifying said first set of programming code and said second set of programming code of terms of any one of said offers and counteroffers that converge according to said negotiating discipline.

With respect to independent Claim 49, at page 7 of the Office Action, Owen is referred to as being "in the same field of endeavor" as Gell. However, while Owen discloses a connection management system for setting up connections in a telecommunication network, as described above, Gell is directed to an accounting system that provides accounting for sales of telecommunications services. Furthermore, the Office Action does not indicate



any objective motivation for combining Gell with Owen. Instead, at page 8 of the Office Action, it is stated that “[t]he motivation would have been to improve the throughput of the network”. Similarly as described above with respect to the lack of motivation for combining Owen with O’Brien, this statement constitutes a subjective supposition that is unsupported by any **objective** teaching in the art. Accordingly, this rejection should be withdrawn, because the Office Action fails to make out a *prima facie* case of obviousness, since it does not set forth any **objective** evidence (other than an unsupported opinion) as to the motivation which would lead the person of ordinary skill in the art at the time to combine the cited references in the manner proposed.

Furthermore, even if sufficient motivation to combine Gell and Owen is assumed to be present, Applicants submit that the combination of Gell and Owen fails to disclose each and every element of independent Claim 49. Independent Claim 49 recites “receiving, from said second set of programming code, another offer . . . said another offer . . . including a modification of said first user interface’s offer;” (emphasis added). However, at page 7 of the Office Action, this element appears to have been misrepresented as “receiving . . . another offer . . . said another offer . . . including a modification of said first user receiving, from said second set of interface’s offer;” (emphasis added). Thus, in contrast to the disclosure of Gell, which apparently refers to a modification of said first user receiving, from said second set of interface’s offer, independent Claim 49 does not require any offer from said second user interface, but rather recites a

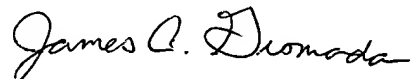
modification of said first user interface's offer being included in another offer from said second set of programming code.

Accordingly, Applicants respectfully submit that the combination of Gell with Owen is improper, for the same reasons as described above with respect to the improper combination of Owen with O'Brien. Further, Applicants respectfully submit that even if the combination is proper, the combination of Gell and Owen fails to disclose the step of receiving another offer that includes a modification of said first user interface's offer, as recited in independent Claim 49. In addition, each of Claims 50 and 51 depends from Claim 49, and is therefore allowable for the same reasons as described above.

In view of the above remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3500. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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